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Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte KÉLAN C. SILVESTER

Appeal No. 2003-0185
Application No. 09/189,250

ON BRIEF

Before BARRETT, FLEMING and NAPPI, **Administrative Patent Judges.**
NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of
claims 26-38, which constitute all the claims in the application.

Invention

The invention relates to a method of handling telephonic messages left by
callers. The method involves identifying the source (caller) of the telephonic
message and converting a portion of the telephonic message to text, see
appellant's specification page 2. The conversion of the message is performed

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by speech-to-text conversion software, depicted in figure 1 as item 26, and discussed on page 3, line 21 and page 5, lines 7-10 of appellant's specification. The identity of the caller and the portion of the message are then displayed to a user by a graphical user interface, see page 6 line 20 to page 7 line 5 of appellant's specification and figure 4.

Independent Claim 26 is representative of the invention

26. A method comprising:

identifying information about the source of a telephonic message;

selecting a portion of said message;

converting said portion to text;

exporting said portion and said source information into a graphical user interface that displays a log of telephone calls including the source information and information about the subject matter of the message; and

displaying said portion in said graphical user interface including displaying the source of said message and using said portion to indicate information about the subject matter of the message.

References

The references relied upon by the examiner are as follows:

Pepe et al.	5,742,905	April 21, 1998
Greco et al.	5,568,540	October 22, 1996

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Rejection at Issue

Claims 26-38 are rejected under 35 U.S.C. § 103 as being unpatentable over Pepe et al. in view of Greco et al. Throughout the opinion we make reference to the briefs¹ and the answer for the respective details thereof.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellant and examiner, for the reasons stated *infra* we affirm the examiner's rejection of claims 28-38 under 35 U.S.C. § 103.

¹¹ Appellant filed an appeal brief on January 17, 2002 (Certified as being mailed on Oct. 30, 2001 in accordance with 37 C.F.R. §1.8(a)). Appellant filed a reply brief dated May 8, 2002 (Certified as being mailed on April 23, 2002 in accordance with 37 C.F.R. §1.8(a)). The examiner mailed out an Office communication on June 27, 2002 stating that the reply brief has been considered.

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At the outset we, we note that appellant states on page 6 of the brief that "all of the claims may be grouped". 37 C.F.R. § 1.192(c) (7) (July 1, 2001) as amended at 62 Fed. Reg. 513196 (October 10, 1997), which was controlling at the time of appellant filing the brief, states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis if that claim alone unless a statement is included that the claims of the group do not stand or fall together and in the argument under paragraph (c) (8) of this section appellant explains which the claims of the group are believed to be separately patentable. Merely pointing out the differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider the appellant's claims as standing or falling together and we will treat claim 26 as a representative claims of that group. **See also In re McDaniel** 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("if the brief fails to meet either requirement [of 37 CFR 1.192(c)(7)] the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.") **See also In re Watts** 354 F.3d 1362, 69 USPQ2d 1453, (Fed. Cir. 2004).

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Appellant identifies, on page 6 of the brief that claim 26 includes the limitation "selecting a portion of a telephonic message, and converting the portion to text". Appellant also argues on page 6 of the brief that Pepe does not teach "taking a portion of a voice mail and converting that portion to text as is required in Applicant's independent claims." We note the difference between the claim language and the argument presented by the applicant is that the claim calls for a "telephonic message" and not a "voice mail" as argued.

Before considering the teachings of Pepe et al, we must first determine the scope of the claim. Claims will be given their broadest reasonable interpretation consistent with the specification, limitations appearing in the specification will not be read into the claims. *In re Etter* 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). In analyzing the scope of the claim, office personnel must rely on the appellant's disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). "[I]nterpreting what is *meant* by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'" (emphasis original) *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing *Intervet America Inc v. Kee-*

Vet Laboratories Inc. 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). “[T]he terms used in the claims bear a “heavy presumption” that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.” **Texas Digital Sys, Inc. v. Telegenix, Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002). “Moreover, the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted.” (citation omitted). “Indeed, the intrinsic record may show that the specification uses the words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be rejected.” **Texas Digital Systems, Inc. v. Telegenix, Inc.**, 308 F.3d at 1204, 64 USPQ2d at 1819 (Fed. Cir. 2002). (“[A] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty.”); *Id.* (citing **Liebscher v. Boothroyd**, 258 F.2d 948, 951, 119 USPQ 133, 135 (C.C.P.A. 1958) (“Indiscriminate reliance on definitions found in dictionaries can often produce absurd results.”)). “In short, the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning.” *Id.* “Further, the presumption also will be rebutted if the inventor has disavowed or disclaimed

scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.” *Id.*

As appellant identifies on page 6 of the brief, claim 26 includes the limitations of “identifying information about the source of a telephonic message; selecting a portion of said message; converting said portion to text”. The appellant’s specification does not directly provide a definition of what is meant by a telephonic message. The plain meaning of telephonic message is a message left using a telephone. The appellant’s specification also refers to a voice message. Appellant’s specification on page 1 states: “Telephonic messages are conventionally handled by answering machines or voice mail systems. These systems generally record the incoming voice message using either analog or digital formats.” We interpret this passage to mean that a voice message may be part of a “telephonic message” and as such we consider a “telephonic message” to be broader than a “voice message”. Accordingly, we find that the term “telephonic message” to include all information provided by the person using the telephone to create a message, including voice and/or any other data².

² For example it is known that a user can telephonically send data in means other than by a spoken message. One example is found in Pepe et al. column 28 line 42, which states that a voice mail sender can mark a message urgent. Other example are using TTY or navigating a menu of choices using a touch-tone phone to generate a message.

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Having determined the scope of the relative portion of the claims we next turn to the rejection based upon 35 U.S.C. § 103. It is the burden of the examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by the implication contained in such teachings or suggestions. *In re Sernaker* 702 F2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance MFG. V SGS Importers Int'l Inc.*, 73 F3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing *W.L. Gore & Assocs., Inc. Garlock, Inc.*, 721 F2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

In response to the appellant's arguments, the examiner, on page 7 of the answer, states:

Pepe [et al] also teaches an AMIS-Digital Protocol. It is with this digital protocol that urgency of voice messages can be detected and sent in the e-mail notifications to subscribers as taught in Col. 28, lines 41-46 and Col. 20, lines 41-53.

We concur with the examiner's statement. **Pepe et al.** in column 28 line 49 identifies that a voice message can be marked as urgent by the user. We find that the identification of a message as urgent is part of the message. Further, **Pepe et al.** in column 20 lines 46-53, identifies that the e-mail

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notification includes "whether the message is marked urgent." Pepe et al. in column 20, line 14 identifies that e-mail is formatted as text. Accordingly, we find that Pepe et al. teaches converting a portion of the message, the user's identification of the message as urgent, to text and producing an e-mail notification of the message including the indication of it being marked urgent.

The examiner asserts, on pages 7 and 8 of the answer, that with respect to the "subject matter" limitation of claim 26 "a subject portion relates to the nature of the call." The examiner relies upon, page 6, lines 24-26 of the appellant's specification to support this finding. Further, on pages 7 and 8 of the answer, the examiner equates urgency with the claimed "subject matter."

In response to the examiner's interpretation of urgency being equated to "subject matter" appellant, on page 1 of the reply brief, states:

"The definition of subject matter of the call is clear and does not mean how urgent is the call. It is contrary to the well accepted English usage to suggest that an indication of the urgency of the call tells the subject matter of the call.

....
The term subject matter is clear. It includes the nature of the call, but not how urgent is the call. It includes the subject matter of the call, not its urgency. Therefore, merely providing information about the urgency of the call does not meet the claimed invention."

Claim 26 contains the limitation "using said portion to indicate information about the subject matter of the message." As there is no disagreement that the claim limitation of "subject matter" relates to the nature of the call, we only look

to whether urgency is to be included in the scope of this limitation. Appellant has not provided a definition of the term "subject matter" in the specification. The examiner, on page 8 of the answer, relies on extrinsic evidence to support his interpretation that "subject matter" for electronic messages can include urgency. The evidence the examiner relies upon is found in Pepe et al. column 35, lines 49-51, which states "[s]ubjects may include 'urgent', 'personal', the name of a client or project, etc." Appellant's arguments, rely on "accepted English usage" but do not rely upon any evidence of record.

We find that appellant's argument that "[t]he definition of subject matter of a call is clear and does not mean how urgent is the call" is not supported by appellant's specification. Appellant's specification, on page 6, describes the portion of the message to become the subject matter as follows:

the message is recorded and stored as indicated at block 314. The message is then converted from speech-to-text for application display as indicated at block 316. Thus, a portion of the message, together with the identity of the caller, may be converted into text format for display on a graphical user interface. The graphical user interface may provide sufficient information so that the user can determine the nature of the call quickly

This does not describe a mechanism which would exclude the urgency of a message from being the "subject matter."

Thus, we find that that the both extrinsic evidence and intrinsic evidence contradicts the definition of the "subject matter" limitation provided by the

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appellant in the reply brief. Accordingly, we find that the scope of the limitation of "subject matter" in claim 26 to include the urgency of the call.

In the paragraph bridging pages 6 and 7 of the brief appellant asserts that the sections of Pepe et al. which the examiner relies upon in the rejection are directed to both the situation where voice mail is converted to e-mail and e-mail is converted to voice mail. Further, on page 7 of the brief the appellant argues that

with respect to the language at lines 52 and 53 of column 20,[of Pepe et al] where it states that "if appropriate, the subject of the message" is included. It is respectfully submitted that this reference is to the situation where an e-mail, which necessarily has a subject, is being converted to a voice mail.

Appellant further supports this argument by referring to column 27, lines 62 through 66 and column 28, lines 15-23 of Pepe et al., which describes how an e-mail notification of a voice message is created. Appellant points out that since these sections do not mention the inclusion of a subject of the voice mail, the language of column 20, lines 52 and 53 is not directed to voice mail notification.

On page 7 of the answer, the examiner responds to this argument stating:

A close reading of the passages at Col 27 and 28 and the context of related teachings in Col. 27, lines 22-28 show that the lack of subject information is apparently due to the use of the AMIS-Analog Protocol. **Pepe** [et al.] also teaches an AMIS-Digital Protocol. It is with this digital protocol that urgency of voice messages can be detected.

We concur with the examiner's assessment. As we stated above we find that the indication that a message is "urgent" to be within the scope of the claimed "subject matter." In column 20, lines 46-51, Pepe et al. states, "The body of the notification E-mail contains ... whether the message is marked urgent (if detectable)". In column 28, lines 41-45, Pepe et al. identifies that the AMIS-Digital Protocol can be used to mark a message as urgent. We interpret these two sections of Pepe et al. in combination to teach that when AMIS-Digital Protocol is used, the e-mail notification will include an indication of whether the message is urgent. Thus, whether the language in column 20 lines 52-53 of Pepe et al. corresponds to a voice message notification or an e-mail notification is irrelevant to our holding as we find the description in column 20 lines 46-51, of Pepe et al. does apply to voice messages.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellant [see 37 CFR § 1.192(a)] Support for this rule has been demonstrated by our reviewing court in *In re Berger* 279 F3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the Federal Circuit Court

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stated that because the appellant did not contest the merits of the rejections in his brief to the Federal Circuit Court, the issue is waived. ***Also see In re Watts*** 354 F.3d 1362, 13268, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

In view of the forgoing, we have sustained the examiner's rejection of claims 26-38 under 35 USC § 103.

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No time period for taking any subsequent action in connection with this
appeal may be extended under 37 CFR§ 1.136 (a).

AFFIRMED



LEE E. BARRETT
Administrative Patent Judge



MICHAEL R. FLEMING
Administrative Patent Judge



ROBERT E. NAPPI
Administrative Patent Judge

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